

Appln No. 10/673,828
Amdt date December 23, 2005
Reply to Office action of July 26, 2005

REMARKS/ARGUMENTS

Claims 1-22 remain in the present application, of which claims 1, 14 and 22 are independent. None of the claims is amended herein.

I. Telephone Interview

Applicant thanks the Examiner for the time and courtesy extended to Applicant's attorney during the telephone interview of November 1, 2005. During the telephone interview, claims 1-22 have been discussed in reference to the judicially created doctrine of double patenting rejection. No agreement was reached as to the patentability of these claims. The Examiner, however, agreed to reconsider the rejection upon filing of a declaration by one of the inventors. The Examiner also suggested that a reference be filed that describes different types of lasers. Both the declaration and the reference (in an Information Disclosure Statement) are attached hereto.

II. Double Patenting Rejection of Claims 1-22

Claims 1-22 were rejected under the judicially created doctrine of double patenting over claims 1-22 of U.S. Patent No. 6,670,574. ("the '574 patent"). While rejecting these claims, the Examiner admits that "the conflicting claims are not identical," but the Examiner contends that "they are not patentably distinct from each other because the independent claims only differ from the patented claim with respect to the word pulse. The formation of a pulse in the operation of a laser is inherent in its very nature. Thus the application

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claims are essentially a duplicate of the patented claims." (Emphasis Added). In response to Applicant's arguments in the response mailed May 9, 2005, the Examiner again contends "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the independent claims only differ from the patented claim with respect to the word pulse. The formation of a pulse in the operation of a laser is inherent in its very nature."

Applicant traverses as follows. There are different types of lasers in use today, some are pulsed while others are not pulsed. According to the attached §1.132 declaration by Gregory Bates, one of the inventors on the instant application, the "[d]ifferent types of lasers include continuous wave (CW) lasers and pulsed lasers. As their respective names indicate, a CW laser generates a single continuous beam of laser output while a pulsed laser generates laser pulses as its output. Laser pulses are generated by the laser beam being temporarily off followed by an on state in a repetitive fashion. In view of these different types of lasers, the formation of a pulse in the operation of a laser is not inherent in its very nature."

Since the claims 1-22 of the present application are not identical to the claims 1-22 of the '574 patent, Applicant believes that the rejection of claims 1-22 under the judicially created doctrine of double patenting is an obviousness type double patenting rejecting that can be overcome by filing a terminal disclaimer under 37 CFR § 1.321. Such obviousness type double patenting rejection is in accordance with Chart II-B entitled "CONFLICTING CLAIMS BETWEEN: APPLICATION AND A PATENT"

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in MPEP § 804, which indicates "Obviousness Double-Patenting Rejecting" in case of different inventions by the same inventive entity that are not patentably distinct, which appears to be the case here according to the Office Action.

A proper terminal disclaimer was submitted to the Patent Office on May 9, 2005 together with a response to the February 7, 2005 Office Action. A copy of the terminal disclaimer is attached hereto for the Examiner's reference convenience. Since the terminal disclaimer has already been filed to obviate the obviousness type double patenting rejection, Applicant requests that the rejection of claims 1-22 be withdrawn and that they be allowed.

The Examiner also states in the Office Action that "there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent," and cites *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968) and MPEP §804. Applicant submits, however, that *In re Schneller* is not applicable to the rejection in the instant application because according to MPEP §804, the type of double patenting rejection illustrated in *In re Schneller* "is applicable even where the inventions claimed in two or more applications/patents are considered nonobvious over each other."

Since the rejection of claims 1-22 in the present application is that of obviousness type double patenting rejection, The circumstances surrounding the rejection in the instant application is distinguishable from the circumstances in *In re Schneller* which is only to be applied in rare

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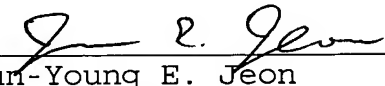
circumstances according to MPEP §804, and therefore, *In re Schneller* should not be applied here.

III. Concluding Remarks

In view of the foregoing remarks, Applicant requests an early issuance of a patent with claims 1-22. If there are any remaining issues that can be addressed over the telephone, the Examiner is cordially invited to contact Applicant's attorney at the number listed below.

Respectfully submitted,

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